

REMARKS

Applicant understands that claims 1-14 are pending in that application, and that the Office currently holds claims 1-14 as rejected.

35 USC §102(e)**Lin et al., US Patent No. 5,528,235**

The Office holds claims 1 and 2-14 rejected under 35 USC §102(e) as being anticipated by the Lin '235 patent. Applicant respectfully traverses this rejection.

The Federal Circuit has stated: "[i]f the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 USPQ 2d 1443, 1444. Applicant submits that the standard for finding a *prima facie* case of anticipation is one of strict identity. In other words, to anticipate under §102, a single prior art reference must disclose all the elements, or disclose their equivalents functioning in the same way as the claimed invention (*Shanklin Corp. v. Springfield Photo Mount Co.*, 187 USPQ 129, 133). Thus even if the prior art reference includes all the elements that are claimed, if the arrangement of the claimed elements is different from the arrangement of the prior art elements, anticipation will not be present. Further, "too many structural and operational differences" can negate anticipation within the meaning of §102 (*ibid.*, 134).

Applicant submits that the Office has failed to establish a *prima facie* case of anticipation by the Lin '235 reference in that Lin does not disclose all the elements of instant claim 1 arranged and functioning in the same way as the claimed invention, and that there are too many structural and operational differences between certain elements of Lin and instant claim 1 to support a *prima facie* case of anticipation.

Regarding Claim 1: Disclosure of Each of the Claimed Elements Requirement

Applicant submits that the primary elements of instant independent claim 1 include the element: "manually operated actuators. . . each manually operated actuator being selectably operable to provide one of three discrete outcomes."

As to the actuator element of independent claim 1, the Office contends that the Lin '235 patent discloses an array of actuators, wherein each actuator is "selectably operable" to provide "one of three discrete outcomes," and points to figs. 3-5 as showing grounds for the contention.

In response, Applicant submits that the Office has unreasonably mis-characterized the showing of figs. 3-5. In fact, figs. 3-5 of Lin only show two discrete outcomes: one in fig. 4 showing the close of contacts 40D & 42D; the other in fig. 5 showing the close of contacts 40D & 42D and 40B & 42B. Note that there is no outcome shown in fig. 3 (i.e., no contacts closed). Therefore, the specific ground for the rejection cited by the Office (that each actuator is "selectably operable" to provide "one of three discrete outcomes") is not supported by the disclosure pointed to by the Office. Further, because the actuator's features of figs. 3-5 are shown in cross-section, it was unreasonable of the Office not to consider the illustrated element as a whole (i.e., the actuator in its entirety). Failing to consider the actual structural and functional features of the element under consideration as a whole does not support a *prima facie* finding of anticipation.

Additionally, Applicant submits that, had the Office reasonably considered the text of the Lin '235 specification, it would have been clear that the actuator of Lin does not have the same or equivalent structure as the actuator of instant claim 1, and does not function in the same or an equivalent manner. For example, a vertical depression of the instant actuator simultaneously makes two contacts. In contrast, a vertical depression of the Lin actuator simultaneously makes four contacts. Further, a vertical depression the Lin actuator cannot be made to make just two contacts, as does the instant invention. Nor can the instant

invention be made to make four contacts. Therefore, the structure and function of these two elements are not the same, nor are they equivalent.

More particularly, of the actuators of the Lin device each addresses five (not three) different functions (outcomes). See col. 2, lines 53-54: "each key can address five. . . functions;" col. 3, lines 8-9: "each key able to address five. . . functions;" col. 5, lines 22-23: "each key can generate 5 different distinct signals." Therefore, not only are the actuators of claim 1 and the Lin patent structurally different, they cannot be made to function equivalently.

Regarding Claims 2-14: Moot

In view of the failure of the Office to establish a *prima facie* case of anticipation as noted above regarding instant independent claim 1, the rejection of dependent claims 2-14 under §102 is moot.

Krishnan, US Patent No. 6,377,685

The Office holds claims 1, 2, 4-6 and 9 to 14 rejected under 35 USC §102(e) as being anticipated by the Krishnan '685 patent. Applicant respectfully traverses this rejection.

As noted above, the Office has the burden at the initial stage of examination to produce a *prima facie* case of unpatentability, otherwise the applicant is entitled to grant of the patent. Applicant submits that the Office has failed to establish a *prima facie* case of anticipation of the present invention by the Krishnan '685 reference in that Krishnan does not disclose all the elements of instant claim 1 arranged and functioning in the same way as the claimed invention, and that there are too many structural and operational differences between certain elements of the Krishnan device and instant claim 1 to support a *prima facie* case of anticipation.

Regarding Claim 1: Disclosure of Each of the Claimed Elements Requirement

Applicant submits that the primary elements of instant independent claim 1 include the element: "manually operated actuators. . . each manually operated actuator being selectably operable to provide one of three discrete outcomes."

As to the actuator element of independent claim 1, the Office contends that the Krishnan '685 patent discloses an array "having four rows of three manually operated actuators per each row," wherein each actuator is "selectably operable" to provide "one of three discrete outcomes," and points to figs. 1-2, 7, etc. as showing grounds for the contention.

In response, Applicant submits that the Office has mis-characterized the structure and function of the "cluster key" element of Krishnan as reading on the actuator of claim 1, by unreasonably relying on the Krishnan figure drawings alone without reference to the figure descriptions in text of Krishnan. Specifically, the Office's contention that Krishnan discloses "three manually operated actuators per each row" is incorrect. Instead, what Krishnan discloses in Figs 1 & 2 is fifteen manually operated actuators per row, clustered in three groups of five. What Krishnan in fact discloses is: each row having three groups or clusters of actuators (keys), the clusters having at least two keys each (a primary key and preferably four to eight secondary keys). See Krishnan '685 col. 6, lines 53-55; col. 14, lines 17-20; and every claim of 39 claims. The requirement in Krishnan that its key cluster be a plurality of individual actuators is structurally different from the actuator of the present invention, which is only a single key.

Further, in contrast to the present invention, there is no teaching in Krishnan where any single key of a key cluster is capable of having more than one outcome, or that simultaneously pressing multiple keys causes a separate distinct outcome. In fact, Krishnan teaches to the contrary, see '685 col. 7, lines 27-29: "If a primary key is depressed, none of

the associated secondary keys may contact the substrate.” Unlike in the present invention where a vertical depression of the key (actuator) makes two contacts, a similar functioning of the primary key of Krishnan does not.

In the present invention a single key is used to produce multiple distinct outcomes. Krishnan clearly teaches away from the devices using a single key to produce multiple outcomes. See Krishnan ‘685: col. 2, lines 64-67; col. 3, lines 40-43, and lines 56-60, where in each case Krishnan describes a single button or switch (actuator) operable to provide different outcomes by pressing the single actuator in different directions is not the same as and “does not suggest” the Krishnan cluster key arrangement. Therefore, Krishnan clearly teaches away from the single key with multiple functions of the present invention.

Regarding Claims 2, 4-6, and 9-14: Moot

In view of the failure of the Office to establish a *prima facie* case of anticipation as noted above regarding instant independent claim 1, the rejection of dependent claims 2, 4-6, and 9-14 under §102 is moot.

35 USC §103(a):


The Office holds claims 3, and 7-8 rejected under 35 USC §103(a) as being unpatentable over Krishnan in view of Lin. Applicant respectfully traverses this rejection.

In response, Applicant submits that independent claim 1 is not *prima facie* anticipated by either Krishnan or Lin as remarked above, and is therefore allowable. In view of the allowability of instant independent claim 1 under §102, and that claim 1 is not held as rejected under §103, therefore dependent claims 3, and 7-8 are allowable. Therefore, the rejection of claims 3, and 7-8 under §103 is moot.

Applicant believes that the above remarks are fully responsive to the Office Action mailed 12 September 2003. Applicant respectfully requests reconsideration and removal of all rejections of the instant claims, and submits that in view of the above amendments and remarks the application is now in condition for allowance. Applicant respectfully requests the Examiner to contact the undersigned to timely resolve any minor issues that may remain in the application in order to facilitate timely prosecution of this application.

Respectfully submitted,

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Date


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